

Application No. 10/017,789

Response dated August 17, 2004

Reply to Office Action dated June 21, 2004

## **REMARKS**

Applicants kindly thank the Examiner for the opportunity to discuss the terminal disclaimer in this case with her on August 12, 2004.

Claims 11-33 are pending in this application. Claims 1-10 have been cancelled. Favorable reconsideration is requested.

The Examiner has rejected claims 11, 14-18, 21, 23, 24, 25, 26, 29, 30 and 33 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6, 355,021 B1. The Examiner has rejected the terminal disclaimer filed with the Amendment dated March 22, 2004 for failure to comply with 37 CFR 1.321 (b) and/or (c).

Applicants have submitted herewith a terminal disclaimer to overcome the rejection based on the nonstatutory double patenting grounds set forth by the Examiner. Applicants have also submitted a copy of the Power of Attorney filed with the parent application 09/115,340, from which the present application is a continuation, in support of compliance with 37 CFR 1.321 (b). The fee for the terminal disclaimer was submitted with the previous response, mailed March 22, 2004. Applicants assert that claims 11, 14-18, 21, 23, 24, 25, 26, 29, 30 and 33 herein are patentably distinct from claims 1-5 of US Patent No. 6,355,021 B1 but have filed a terminal disclaimer in order to expedite the allowance of the pending claims.

Applicants filing of the terminal disclaimer for claims 11, 14-18, 21, 23, 24, 25, 26, 29, 30, and 33 should also overcome the objection to claims 12, 13, 22, 27, 28, 31 and 32. With the filing of the terminal disclaimer for 11, 14-18, 21, 23, 24, 25, 26, 29, 30, and 33, claims 12, 13, 22, 27, 28, 31 and 32 no longer depend from rejected claims.

Applicants note that claims 19 and 20 have not been allowed or rejected in this Office Action. Applicants assert that claims 19 and 20 are also in condition for allowance with the filing of the terminal disclaimer.

Having carefully addressed all the objections and rejections of the Examiner in the June 21, 2004 Office Action, it is respectfully asserted that the claims properly

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define the invention and that the invention is both novel and non-obvious. Allowance of the present claims is earnestly solicited.

Should the Examiner wish to discuss any of the above submissions in more detail, the Examiner is asked to please call the undersigned at the telephone number listed below.

Respectfully submitted,

  
Heidi A. Dare  
Heidi A. Dare  
Registration No. 50,775  
Attorney for Applicant

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**APPENDIX**

"Express Mail" mailing label number EL392679939US

Date of Deposit 12/13/2001



**REQUEST FOR FILING A CONTINUING APPLICATION UNDER 37 CFR § 1.53(b)(1)**

Case No.	ANTICIPATED CLASSIFICATION OF THIS APPLICATION		PRIOR APPLICATION EXAMINER	ART UNIT
	CLASS	SUBCLASS	Patricia M. Bianco	3762
8465/17				

**Address to:**

Commissioner for Patents  
Washington, D. C. 20231

This is a request for filing a  continuation  divisional application under 37 CFR § 1.53(b)(1), of pending prior application number 09/115,340, filed on July 14, 1998, entitled MEDICAL PUNCTURING DEVICE.

1.  Copy Of the Prior application, including 8 sheets of drawings, 11 pages of Application (including title page), and the following Appendices \_\_\_\_.
  2.  Copy of the Declaration filed in the Prior application.
  3.  PTO Form 1449 and Information Disclosure Statement.

CLAIMS	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
	TOTAL CLAIMS (37 CFR 1.16(c))	23 - 20 =	3	x \$ 18 =	\$54
	INDEPENDENT CLAIMS (37 CFR 1.16(b))	3 - 3 =	0	x \$ 84 =	\$0
	MULTIPLE DEPENDENT CLAIMS (if applicable) (37 CFR 1.16(d))			+ \$280 =	\$ 0
			BASIC FEE (37 CFR 1.16(a))		\$ 740
			Total of above Calculations =		\$
	Reduction by 50% for filing by small entity (Note 37 CFR 1.9, 1.27, 1.28)				\$
			TOTAL =		\$794.00

4.  A verified statement to establish small entity status under 37 CFR 1.9 and 1.27
    - is enclosed.
    - was filed in prior application number \_\_\_\_\_ and such status is still proper and desired (37 CFR 1.28(a)).
  5.  The Commissioner is hereby authorized to charge any fees which may be required under 37 CFR 1.16 and 1.17, or credit any overpayment to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.
  6.  Enclosed is a check for \$ 794.00 to cover the filing fees.
  7.  Cancel in this application all original claims of the prior application and otherwise enter the attached preliminary amendment before calculating the filing fee. (At least one original independent claim must be retained for filing purposes).
  8.  The inventor(s) of the invention being claimed in this application is(are): Jan Willum Nielsen, Bjorn Gullack Larsen, Orla Mathiasen, Marc Delzac and Claude Teisen-Simony.
  9.  This application is being filed by less than all the inventors named in the prior application. In accordance with 37 CFR 1.63(d)(2), the Commissioner is requested to delete the name(s) of the following person or persons who are not inventors of the invention being claimed in this application: \_\_\_\_\_.
  10.  Amend the specification by inserting before the first line the sentence: "This application is a  continuation  division of application number 09/115,340, filed 7/14/98, (pending), which is hereby incorporated by reference herein."
  11.  New formal drawings are enclosed.

12.  Priority of foreign application number \_\_\_\_\_, filed on \_\_\_\_\_ in \_\_\_\_\_ is claimed under 35 U.S.C. 119.  
 The certified copy has been filed in prior application number \_\_\_\_\_, filed
13.  A preliminary amendment is enclosed.
14.  The prior application is assigned of record to Maersk Medical A/S.
15.  Also enclosed: \_\_\_\_\_
16.  The power of attorney in the prior application is to: William A. Webb and other attorneys at the firm of BRINKS HOFER GILSON & LIONE.
- a.  The power appears in the original papers in the prior application.
  - b.  Since the power does not appear in the original papers, a copy of the power in the prior application is enclosed.
  - c.  Address all future correspondence to: (may only be completed by applicant, or attorney or agent of record.)

David Rozenblat  
\_\_\_\_\_  
BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, IL 60610  
(312)321-4200

12/13/2001

Date



Signature

Name: David Rozenblat  
Reg. No. 47,044

- Inventor(s)  
 Assignee of complete interest  
 Attorney or agent of record  
 Filed under 37 CFR 1.34(a)  
Registration Number if acting under 37 CFR 1.34(a): 47,044.

Inventor(s): Jan Willum Nie, Bjørn Gullak Larsen, Orla Mathiasen, Marc L. Sac and Claude Teisen-SimonyTitle: Medical Puncturing Device

## POWER OF ATTORNEY

- The specification of the above-identified patent application:
- is attached hereto
- was filed on July 14, 1998 as Application Serial No. 09/115,340.

I hereby revoke all previously granted powers of attorney in the above-identified patent application and appoint the following attorneys to prosecute said patent application and to transact all business in the Patent and Trademark Office connected therewith:

William A. Webb (28,277)  
 Craig A. Summerfield (37,947)  
 Joseph F. Hetz (41,070)



Please address all correspondence and telephone calls to William A. Webb in care of:

Brinks Hofer Gilson & Lione  
 P.O. Box 10395  
 Chicago, IL 60610  
 (312)321-4200

The undersigned hereby authorizes the U.S. attorneys named herein to accept and follow instructions from Mikael Tranekaer Christensen as to any action to be taken in the Patent and Trademark Office regarding this application without direct communication between the U.S. attorney and the undersigned. In the event of a change in the persons from whom instructions may be taken, the U.S. attorneys named herein will be so notified by the undersigned.

Maersk Medical A/S, a corporation of Denmark, certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of either:

- An assignment from the inventor(s) of the patent application identified above, a copy of which is attached hereto.  
 OR
- An assignment from the inventor(s) of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel \_\_\_\_\_, frame \_\_\_\_\_.  
 OR
- A chain of title from the inventor(s), of the patent application identified above, to the current assignee as shown below:

1. From \_\_\_\_\_ To:  
 The document was recorded in the Patent and Trademark Office at Reel \_\_\_\_\_, frame \_\_\_\_\_, or a copy thereof is attached.
2. From \_\_\_\_\_ To:  
 The document was recorded in the Patent and Trademark Office at Reel \_\_\_\_\_, frame \_\_\_\_\_, or a copy thereof is attached.

Additional documents in the chain of title are listed on a supplemental sheet.

The undersigned has reviewed the assignment or all the documents in the chain of title of the patent application identified above and, to the best of undersigned's knowledge and belief, title is in the assignee identified above.

The undersigned (whose title is supplied below) is empowered to act on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signature: Jesper Funding Andersen Date: 24/7/98  
 Name: Jesper Funding Andersen  
 Title: General Manager

Rev. Oct. 97

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